

REMARKS

Claims 1-30 are all the claims now pending.

I. Drawings

The drawings stand objected to under 37 C.F.R. § 1.84. Applicant submits herewith a set of formal drawings in which corrections were made to the initially filed drawings. As suggested by the Examiner, the angled line bordering Figs. 3 and 4 has been removed. Furthermore, Figs. 3/4 and the specification have been amended to refer to reference number 79 as the receiving socket and to continue to refer to reference number 78 as holes. Accordingly, Applicant requests that the objection to the drawings be reconsidered and withdrawn.

II. Specification

The Examiner has listed a number of informalities in the specification and claims that were required to be corrected. Such corrections have been made in the present amendment. Accordingly, applicant requests that corrections be acknowledged and accepted.

III. Claim Rejections under 35 U.S.C. § 112, first paragraph

Claims 26-28 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to enable claims reciting wings to contain openings for attachment of an external apparatus. The examiner acknowledges that the specification enables wings having openings for armrests, handles and an utility basket. Each of these are examples of an external apparatus. Therefore, by the examiner's own acknowledgement, the specification enables at least three types of external apparatus. As long as the specification discloses at least one method or example for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Failure to disclose every example by which the claimed

invention may be made does not render a claim invalid under 35 U.S.C. 112. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir.), *cert. denied*, 484 U.S. 954 (1987). Accordingly, since the examiner has acknowledged that the specification enable at least three types of external apparatus (armrests, handles, utility basket), Applicant submits that the specification clearly enables claims 26-28.

Furthermore, the examiner has failed to provide any explanation as to why one reasonably skilled in the art could not make or use the invention recited in claims 26-28 without undue experimentation. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *United States v. Telecommunications, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). See also: *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); and MPEP § 2164.01.

The examiner must provide a reasonable explanation as to why the scope of protection provided by the claims is not adequately enabled by the disclosure. MPEP § 2164.04. “It is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.” *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). According to *In re Bowen*, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. The language should focus on those factors, reasons, and evidence that lead

the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. Specific technical reasons are always required. MPEP 2165.04.

Here, the examiner has not provided any specific technical reasons or any reasons at all for the uncertainty of the enablement. The examiner has instead provided only a broad conclusory statement that “[t]he specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.” However, this broad conclusory statement does not satisfy the examiner’s burden of providing specific technical reasons as to why the claims are not enabled.

Since the examiner has acknowledged that at least three examples of external apparatus are enabled by the specification and since the examiner has not met the initial burden of providing specific technical reasons as to why the claims are not enabled, Applicant requests that the rejection of claims 26-28 under 35 U.S.C. § 112 be reconsidered and withdrawn.

Claims 29-30 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the enablement requirement. As stated above, the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. There are many factors to be considered when determining whether a disclosure satisfies the enablement requirement and whether any necessary experimentation is “undue”. As set forth in MPEP § 2164.01(a), the factors include, but are not limited to:

- (A) The breadth of the claims;

- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention.

Here, the Examiner only considers factor (A) in stating that the specification fails to describe or support a method of installing an elevated toilet seat commensurate with these claims. Yet it is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of non-enablement must be based on the evidence as a whole. See MPEP § 2164.01(a).

For example, is it the examiner's position that one skilled in the art of toilet seats, after reading this specification and all relevant publications on toilets installation, would require undue experimentation to remove the standard toilet seat? Applicant would speculate that there are probably hundreds of publications that explain how to remove a standard toilet seat. Similarly, the step of attaching the mounting bracket is described in paragraph 27 and shown in Fig. 2. Specifically, the bolts 30 extend through the holes 38 and are retained by nuts 40 to fasten the mounting bracket to the toilet bowl 20. Again, with respect to the engaging step, paragraph 31 clearly explains how the second attachment element engages the first attachment element.

As with the rejection to claims 26-28, the examiner has once again failed to provide any specific technical reasons as to why these method steps are not enabled or why they require undue experimentation by one skilled in the art. Since the specification provides one skilled in

the art with more than enough explanation of how to make and use the invention recited in claims 29-30 and since the examiner has not met the initial burden of providing specific technical reasons as to why the claims are not enabled, Applicant requests that the rejection of claims 29-30 under 35 U.S.C. § 112 be reconsidered and withdrawn.

IV. Claim Rejections under 35 U.S.C. § 112, second paragraph

Claims 2 and 3 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the limitation “the first” allegedly does not have proper antecedent basis. Applicant has amended the claims and requests that the rejection of claims 2-3 under 35 U.S.C. § 112 be reconsidered and withdrawn.

V. Claim Rejections under 35 U.S.C. § 102

Claims 1-3, 21, 24-27, 29 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ellis (U.S. Patent No. 5,708,989). To be an “anticipation” rejection under 35 U.S.C. § 102, the reference must teach every element and limitation of the Applicant’s claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus the reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Applicant submits that Ellis fails to disclose each and every limitation of the claimed invention. Specifically, regarding independent claims 1, 21 and 29, Applicant submits that Ellis fails to disclose a first attachment element extending from a front edge of the first end portion. The examiner relies on projection 39 as disclosing the first attachment element. As clearly shown in Figs. 1, 2, 5 and 6 of Ellis, the projection 39 extends from a rear edge of the alleged end portion. Ellis fails to teach any attachment element which extends from a front edge of the first end portion. Since Ellis fails to disclose this limitation, Applicant submits that Ellis fails to

anticipate independent claims 1, 21 and 29. Therefore, Applicant requests that the rejection of independent claims 1, 21, and 29 under 35 U.S.C. § 102(b) be considered and withdrawn.

Since claims 2-3, 24-27 and 30 depend from independent claims 1, 21 or 29, and since the Ellis reference does not disclose all of the limitations of independent claims 1, 21, or 29, Applicant submits that claims 2-3, 24-27 and 30 are patentable at least by virtue of their dependency from independent claims 1, 21, or 29. Accordingly, Applicant respectfully requests that the rejections of claims 2-3, 24-27 and 30 under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

VI. Allowable Subject Matter

Claims 11-20 stand allowed. Claims 4-10, 22 and 23 stand objected to but would be allowable if rewritten into independent form. Applicant has rewritten claims 4 and 22 into independent form including all of the limitations of the base claims and any intervening claims. Claims 5-10 depend from new independent claim 4 and claim 23 depends from new independent claim 22. Therefore, Applicant submits that claims 4-10, 22 and 23 are now in allowable form.

Finally, claim 28 contains allowable subject matter if rewritten to overcome the rejection under 35 U.S.C. § 112, first paragraph. Based on the remarks above, Applicant submits that claim 28 now stands in allowable form.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees under 37 C.F.R. § 1.17 or any other section (including extension fees), except for the Issue Fee and the Publication Fee, to Deposit Account No. 03-0172. Please also credit any overpayments to said Deposit Account.

Respectfully Submitted,

Date: 3/16/05


Michael J. Whitehead
Reg. No. 48,071
(216) 622-8525

IN THE DRAWINGS

Please amend the drawings as follows:

Applicant submits formal drawings marked as "Replacement Sheets" having the corrections requested by the Examiner. Additionally, Applicant submits annotated drawings marked as "Annotated Marked-up Drawings" which show the changes made.

FIG. 1

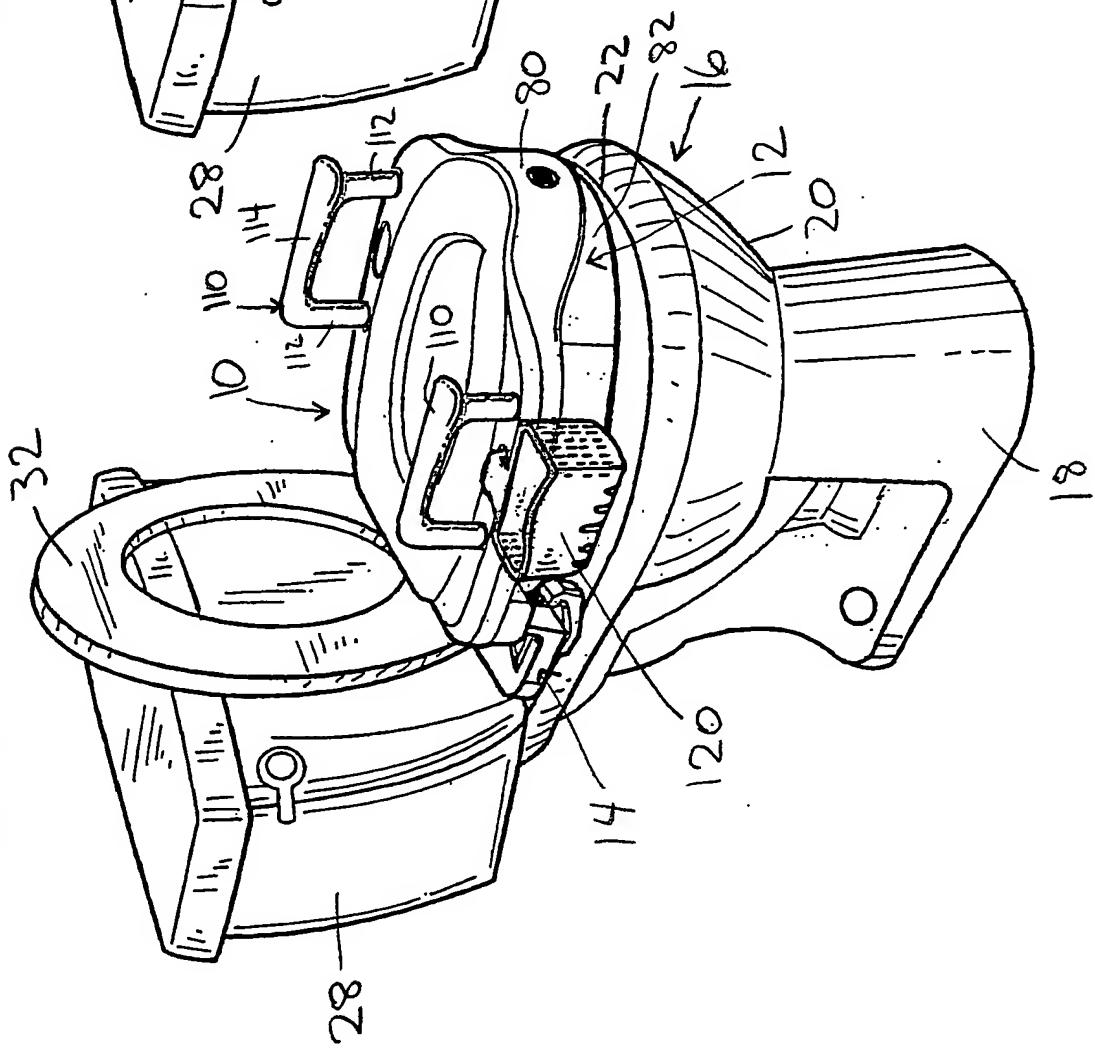
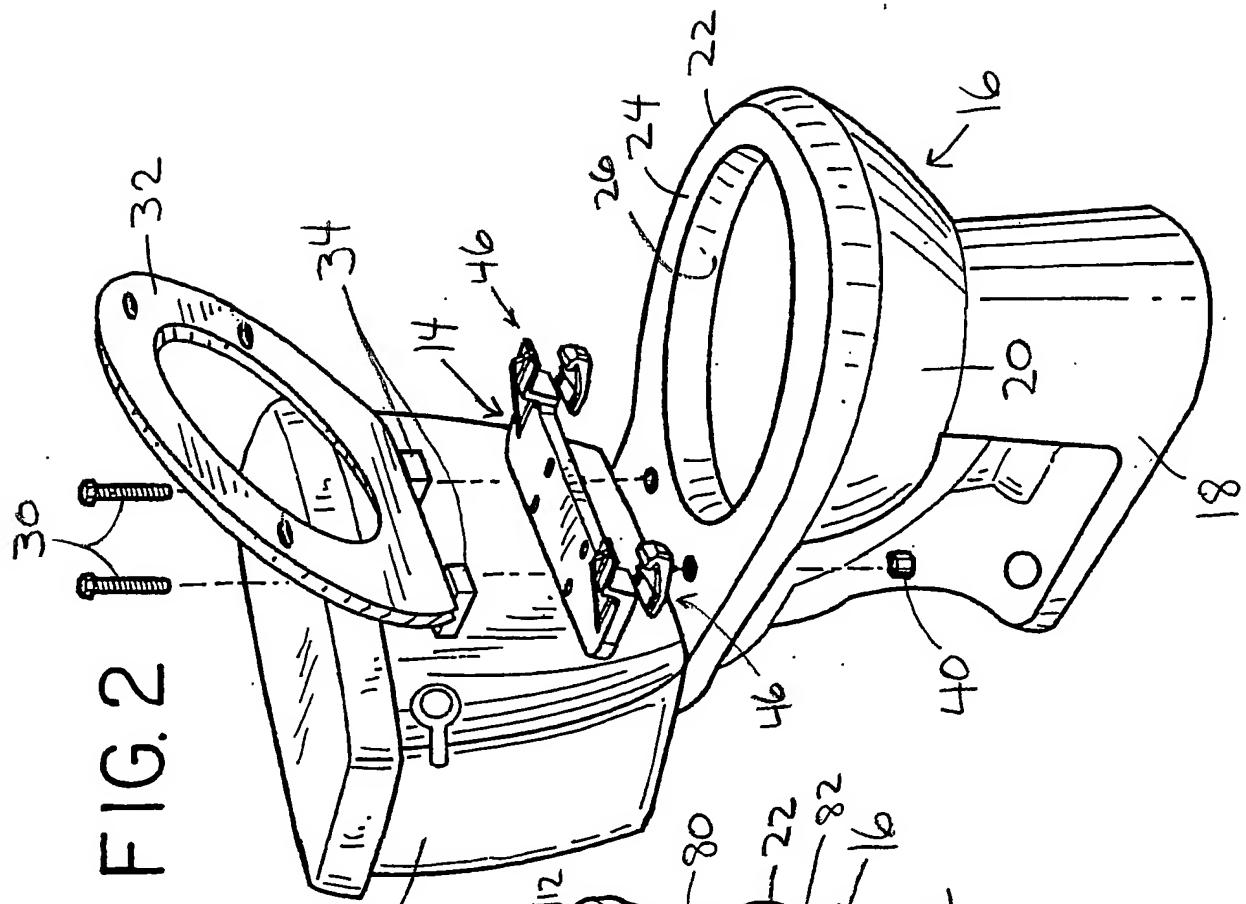


FIG. 2



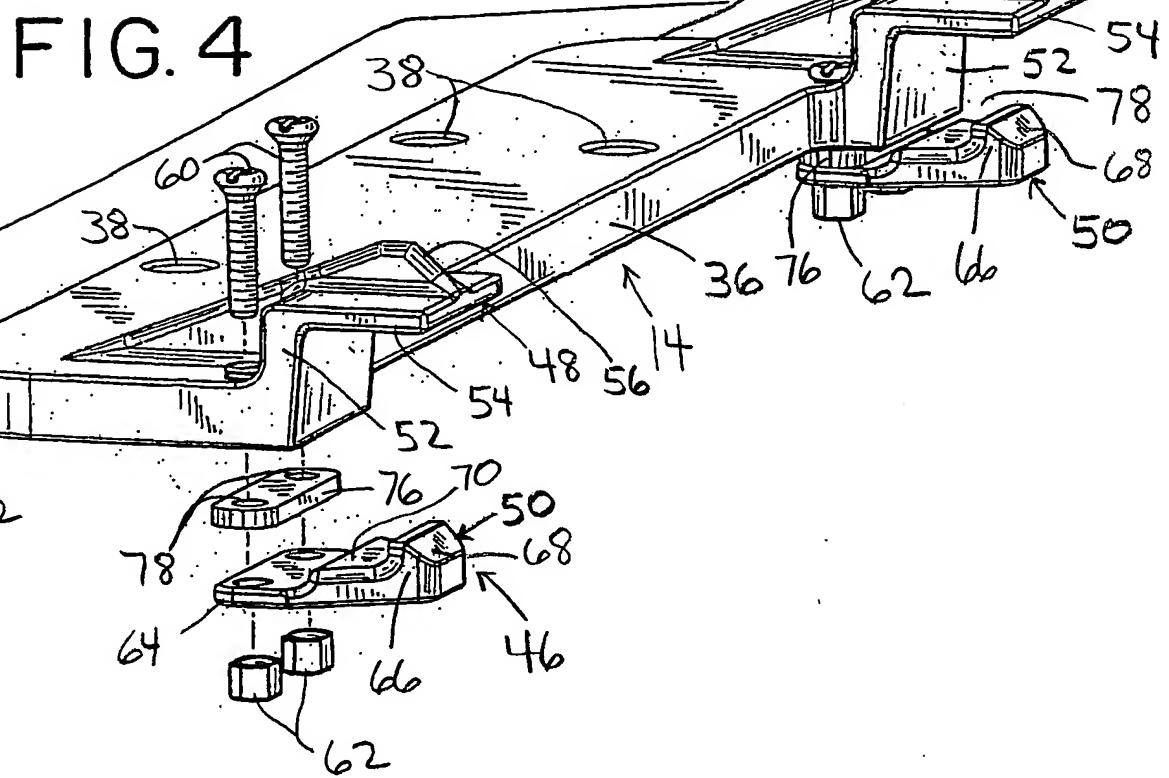
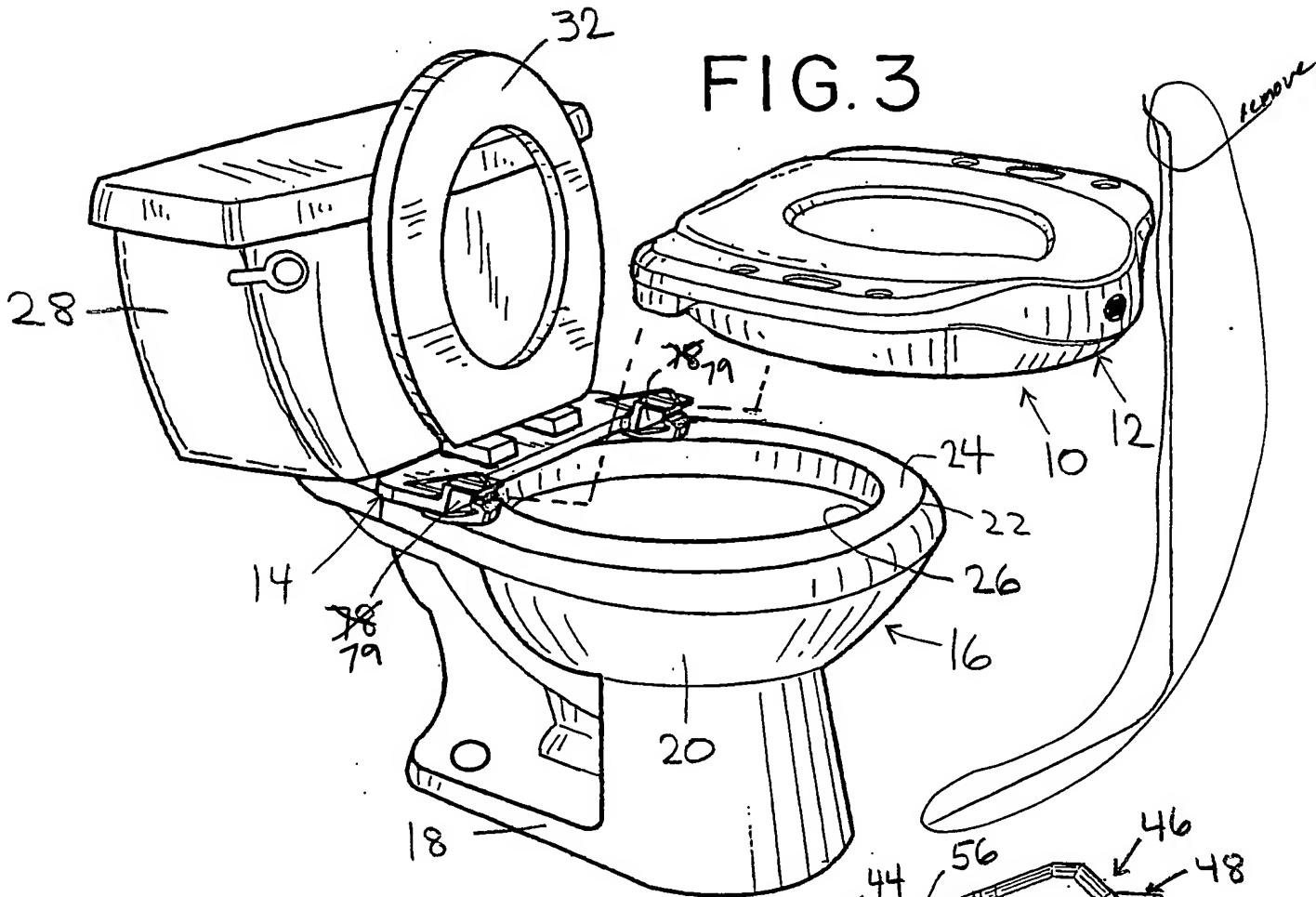


FIG. 5

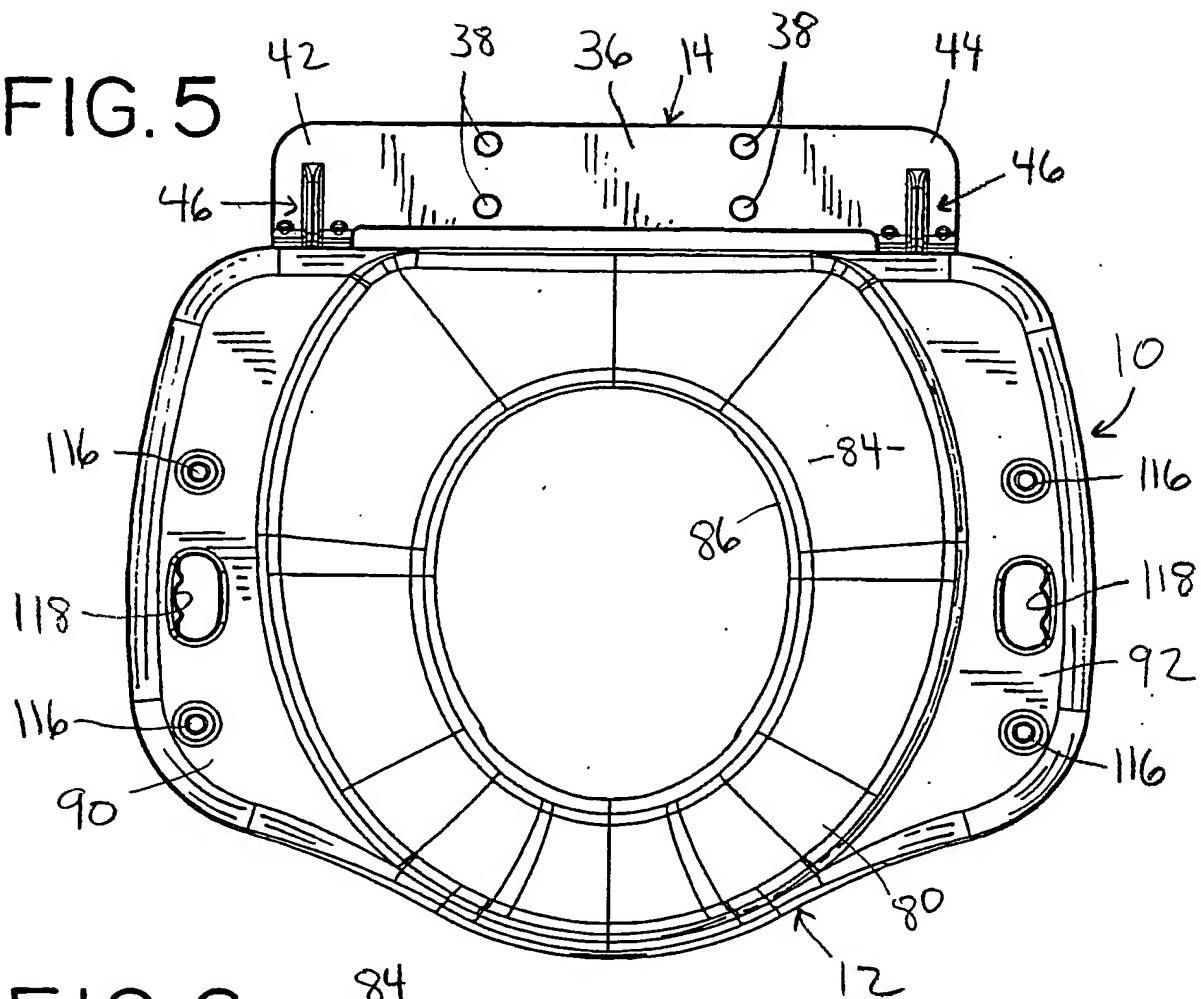


FIG. 6

